



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/594,290

05/07/2007

Katsuya Takigawa

AK-525XX

6319

207

7590

12/30/2009

WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP
TEN POST OFFICE SQUARE
BOSTON, MA 02109

EXAMINER

WEISS, PAMELA HL

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

12/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,290	Applicant(s) TAKIGAWA ET AL.	
	Examiner PAMELA WEISS	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 10 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/14/2009 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 1797

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons et al. (US 2,841,555)

Regarding Claim 14:

Lyons et al. (US 2,841,555) discloses a lubricating composition comprising an alkali metal or alkaline earth metal salt of a N-C₁₀-C₂₄ acyl sarcosine and an oleaginous lubricating base. (C1 L17-22 meeting the limitation for formula C-1) (2)) See MPEP 2144.05(I): "In the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976)."

Lyons discloses the N-acyl sarcosine saponified with alkali metal or alkaline earth metal hydroxide in a portion of oleaginous lubricating base (C1 L30-50) such as mineral oil synthetic oil (C1 L65-68). Lyons et al discloses the composition further comprises additives to impart antioxidant and extreme pressure properties such as sulfurized fats and oils, chlorinated compounds as well as aromatic amine type inhibitors such as diphenyl amine etc. (C2 L25-40).

Lyons discloses the oil may be a mineral oil (C2 L3 or a synthetic base oil (C2 L14). Lyons discloses the grease finds particular application in the lubrication of marine machinery (C1 L25-30)

6. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons et al. (US 2,841,555) in view of Baba (WO 02/092735A1)

Regarding Claim 1:

Lyons et al. (US 2,841,555) discloses a lubricating composition comprising an alkali metal or alkaline earth metal salt of a N-C₁₀-C₂₄ acyl sarcosine and an oleaginous lubricating base. (C1 L17-22) See MPEP 2144.05(I): "In the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976)."

Lyons discloses the N-acyl sarcosine saponified with alkali metal or alkaline earth metal hydroxide in a portion of oleaginous lubricating base (C1 L30-50) such as mineral oil synthetic oil (C1 L65-68). Lyons et al discloses the composition further comprises additives to impart antioxidant and extreme pressure properties such as sulfurized fats and oils, chlorinated compounds as well as aromatic amine type inhibitors such as diphenyl amine etc. (C2 L25-40).

Lyons discloses the grease finds particular application in the lubrication of marine machinery (C1 L25-30)

Lyons does not expressly disclose the extreme pressure additive to be a phosphorus containing carboxylic acid and a thiophosphoric acid.

Art Unit: 1797

Baba discloses a sarcosine containing lubricating composition which uses an extreme pressure additives (P3 L20-25) and comprising a β -dithiophosphorylpropionic acid (P3 L20-25) and Component A(2) as a triaryl phosphorothioate (P4 L1-6). Baba discloses the aforementioned additives may be used together. (P4 L26-30) Baba discloses the oil composition has excellent anti rust properties in severe operating environments in which water or seawater is admixed and exhibits excellent properties in terms of lubrication and anti corrosion in various types of machinery (P1 L1-12).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the extreme pressure additives of Baba as the extreme pressure additive in Lyons as it is suitable for use with sarcosine comprising lubricating compositions and Lyons expressly contemplates an extreme pressure additive which may be sulfurized so including of these additives in the composition of Lyons would amount to nothing more than use of a known composition in a known environment to achieve an entirely expected result.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to add a viscosity index of improver of Baba to the composition of Lyons to impart improved viscosity index qualities to the composition of Lyons.

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,

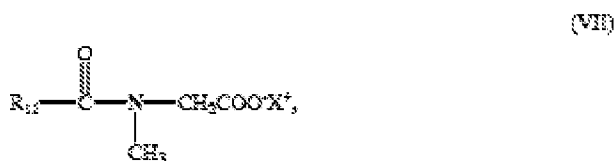
Art Unit: 1797

481 (CCPA 1951). Thus, the language stating that the lubricating oil composition is for industrial machinery equipment is not afforded patentable weight.

7. Claims 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes Gavilan et al. (US 6,410,490).

Regarding Claims 10 and 14:

Reyes Gavilan et al. (US 6,410,490) discloses a lubricant composition stabilized against the deleterious effects of heat and oxygen (Abstract). Reyes Gavilan discloses the lubricating composition comprises oil (C2 L1) and an effective stabilizing amount of an N-acyl sarcosine derivative of formula:



wherein

the acyl group $\text{R}_{11}-\text{C}(=\text{O})-$ is the residue of a fatty acid having 10 to 20 carbon atoms and X^+ is the hydrogen ion, an alkali metal ion or an ammonium ion.

Reyes Gavilan discloses the derivative comprises a hydrogen ion, an alkali metal ion or an ammonium ion meeting the limitation for Y^1 alkali metal or alkali earth metal of formula C-(2). (Reyes Gavilan C3 L30-45 and C7 L20-30)

Reyes Gavilan disclose the composition comprises triphenylphosphorothionate (component A-2 C11 L52-54).

Reyes Gavilan discloses the composition further comprises viscosity index improvers such as polymethacrylate (C11 L38-44) meeting the limitation for component (B).

Reyes Gavilan discloses the composition further comprises stabilizing amounts of a polyol partial ester of mono glycerides and polyols (C7 L31-43) meeting and/or overlapping the limitation for component (D) (See MPEP 2144.05(I): "In the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).")

Reyes Gavilan discloses the composition comprises antioxidants of thiodipropionic esters/ethers (C9 L62-68) Reyes Gavilan discloses additional rust inhibitors of phosphoric acid partial esters and zinc dialkylthiophosphate (C10 L60-65).

Claim 10 requires oil with a component C and a component B or D. Claim 14 requires only one component C. As set forth above, Reyes Gavilan discloses components meeting (and/or overlapping carbon ranges) the limitations of formulas B, C, and D and therefore meets the limitations of claims 10 and 14.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes Gavilan et al. (US 6,410,490) as applied to claims 10 and 14 above further in view of Baba (WO 02/092735A1).

Regarding Claim 1:

Reyes Gavilan discloses the limitations as set forth above which are expressly incorporated herein. Reyes Gavilan discloses the composition further comprises extreme pressure additives. (C11 L27-49)

Reyes Gavilan does not expressly disclose the extreme pressure additive to be a phosphorus containing carboxylic acid.

Baba discloses a similar lubricating composition to that of Reyes Gavilan in that is comprises oil, a sarcosine derivative as well as other additives such as extreme pressure additives, etc. Baba discloses a lubricating composition for hydraulic working oils, gear wheel oils, compressor oils, turbine oils and bearing oils (P22 L18-23) comprising a petroleum based lubricating oil or a synthetic hydrocarbon based base oil (P5 L13-15 and L33-35 and P6 L5-9) and further comprising: an extreme pressure additive of Component A-(1) in the form of a β -dithiophosphorylpropionic acid (P3 L20-25) and Component A-(2) as a triaryl phosphorothioate (P4 L1-6). Baba discloses the aforementioned additives may be used together. (P4 L26-30) Baba discloses the composition further comprises Component (B) a viscosity index agent such as polymethacrylate (P14 L12-14). Baba also discloses N-Oleyl sarcosinic acid (P20 Table 3) and sarcosines and their derivatives (P6 L18-22)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to add the β -dithiophosphorylpropionic acid (component A-1) to the composition of Reyes Gavilan which expressly contemplates the addition of extreme pressure additives, as it may be used with the triaryl (i.e. triphenyl) phosphorothionate of Reyes Gavilan to impart further extreme pressure qualities to the composition of Reyes Gavilan.

9. Claims 1, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baba (WO 02/092735A1) in view of Lyons et al. (US 2841,555).

Regarding Claims 1 and 10

Art Unit: 1797

Baba discloses a lubricating composition for hydraulic working oils, gear wheel oils, compressor oils, turbine oils and bearing oils (P22 L18-23) comprising a petroleum based lubricating oil or a synthetic hydrocarbon based base oil (P5 L13-15 and L33-35 and P6 L5-9) and further comprising:

Component A-(1) in the form of a β -dithiophosphorylpropionic acid (P3 L20-25) and Component A-(2) as a triaryl phosphorothioate (P4 L1-6). Baba discloses the aforementioned additives may be used together. (P4 L26-30).

Baba discloses the composition further comprises Component (B) a viscosity index agent such as polymethacrylate (P14 L12-14).

Baba also discloses N-Oleyl sarcosinic acid (P20 Table 3) and sarcosines and their derivatives (P6 L18-22)

Baba discloses the composition comprising A(1), A(2), B, and (C-2) thereby meeting the limitations of claim 1 for A(1), A(2) and at least one of B, C or D.

Baba discloses the composition comprising A(1), A(2), and (C) thereby meeting the limitations of claim 10 for (C) and at least one of (B) or (D).

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Thus, the language stating that the lubricating oil composition is for industrial machinery equipment is not afforded patentable weight.

Baba also discloses N-Oleyl sarcosinic acid (P20 Table 3) and sarcosines and their derivatives (P6 L18-22) Baba does not expressly disclose the type of sarcosine derivative to be an alkali or alkaline metal salt.

Lyons et al. (US 2,841,555) discloses a lubricating composition comprising an alkali metal or alkaline earth metal salt of a N-C10-C24 acyl sarcosine and an oleaginous lubricating base. (C1 L17-22). N-acyl sarcosine saponified with alkali metal or alkaline earth metal hydroxide in a portion of oleaginous lubricating base (C1 L30-50) such as mineral oil synthetic oil (C1 L65-68). Lyons et al discloses the composition further comprises additives to impart antioxidant and extreme pressure properties such as sulfurized fats and oils, chlorinated compounds as well as aromatic amine type inhibitors such as diphenyl amine etc. (C2 L25-40) Lyons discloses the grease finds particular application in the lubrication of marine machinery. (C1 L25-30) Lyons discloses the composition provides good oxidation resistance and antirust properties. (C1 L25-30)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to add the alkali earth metal or alkaline earth metal hydroxide N-acyl sarcosine of Lyons or Reyes Gavilan to the composition of Baba to impart good oxidation resistance and anti rust properties to the composition of Baba.

Regarding Claim 14:

The rejection to claims 1 and 10 above are expressly incorporated herein. Modified Baba discloses the limitations set forth above.

Baba discloses the composition consisting essentially of (C-1) and/or (C-2) thereby meeting the limitations of claim 14 for synthetic oil and component (C)

The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Thus, the language stating that the lubricating oil composition is for industrial machinery equipment is not afforded patentable weight.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baba (WO 02/092735A1) in view of Lyons et al. (US 2,841,555) as applied to claims 1 and 10 above further in view of Yokota et al. (US 2002/0035043A1)

Regarding Claim 10:

Baba discloses the limitations set forth above. Rejection to claims 1 and 10 set forth in paragraph 3 above are expressly incorporated herein.

Baba also discloses N-Oleyl sarcosinic acid (P20 Table 3) and sarcosines and their derivatives (P6 L18-22) meeting the limitation of C-1-1 (the examiner notes that the

Art Unit: 1797

instant application specification identifies n-oleoyl sarcosine as component C-1-1 at P145 and sarcosine at Table 1 p115) further meeting the limitation of claims 11-12.

Baba discloses that in addition to the aforementioned components, suitable amounts of supplementary additives of the various types which are generally used can be added to the composition. (P9 L8-14) Baba discloses the oil may be petroleum based and synthetic based or mixtures thereof. (P6 L5-9)

Baba discloses the composition may comprise partial esters of monocarboxylic acids.

Baba does not expressly disclose the composition including component (D) an ester of a polyhydric alcohol and a fatty acid of monobasic acid selected from (D-1) to (D-3).

Yokota et al. discloses a lubricating composition for industrial machinery and equipment (cutting and grinding [0010 and 0011]), said composition comprising a base oil selected from mineral oils, fats and oils, synthetic oils and mixtures of two or more of them ([0011] an ester base oil), and at least one additive component (D) :

Yokota et al. also discloses the lubricating oil composition comprising the additive comprises the ester oiliness improver of said component (D) which is an ester of a polyhydric alcohol and a fatty acid of monobasic acids. ([0045] and [0065]).

Yokota et al. discloses that there is no limitation on the combination of alcohols and carboxylic acids ([0067-0074]) Yokota et al. further discloses the oiliness improver may be a full ester or a partial ester ([0075])

Yakota et al. discloses a polyhydric alcohols ([0017] including Sorbitan), monobasic acids ([0021]) and polybasic acids ([0022]). Yakota also discloses that the ester may be any combination of alcohols and acids ([0067]) and may result in partial or full esters when using a polyhydric alcohol ([0073]). the esters of (D-1) to (D-3) would intrinsically result from the possible combinations of alcohols and acids of Yakota thereby meeting the claim limitations:

(D-1): an ester of a polyhydric alcohol and an unsaturated fatty acid containing a partial ester with the degree of esterification of 1 and a partial ester with the degree of esterification of 2 or more;

(D-2) : a whole ester of a polyhydric alcohol and a mixture of fatty acids, wherein the fatty acids are short-chained fatty acids and long-chained fatty acids; and

(D-3) : an ester of a polyhydric alcohol ([0071]) and a branched saturated fatty acid ([0047] wherein the acid may be a branched saturated carboxylic acid) containing a partial ester with the degree of esterification of 1 and a partial ester with the degree of esterification of 2 or more.

Yokota discloses the ester provides lubrication in a minimal quantity lubrication system. ([0010]) Yokota discloses the composition may further comprise a base oil and additives ([0082]) such as corrosion inhibitors, polyacrylates, extreme pressure additives, etc. ([0084]).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to add the ester of Yokota to the composition of Baba since Baba permits

Art Unit: 1797

additional additives and expressly contemplate the use of a partial ester; further, doing so would improve the lubricating properties of the oil of Baba.

11. Claims 1, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baba (WO 02/092735A1) in view of Reyes Gavilan et al. (US 6,410,490).

Regarding Claims 1 and 10

Baba discloses a lubricating composition for hydraulic working oils, gear wheel oils, compressor oils, turbine oils and bearing oils (P22 L18-23) comprising a petroleum based lubricating oil or a synthetic hydrocarbon based base oil (P5 L13-15 and L33-35 and P6 L5-9) and further comprising:

Component A(1) in the form of a β -dithiophosphorylpropionic acid (P3 L20-25) and Component A(2) as a triaryl phosphorothioate (P4 L1-6). Baba discloses the aforementioned additives may be used together. (P4 L26-30).

Baba discloses the composition further comprises Component (B) a viscosity index agent such as polymethacrylate (P14 L12-14).

Baba also discloses N-Oleyl sarcosinic acid (P20 Table 3) and sarcosines and their derivatives (P6 L18-22)

Baba discloses the composition comprising A(1), A(2), B, and (C-2) thereby meeting the limitations of claim 1 for A(1), A(2) and component C

Baba discloses the composition comprising A(1), A(2), B, and (C-2) thereby meeting the limitations of claim 10 for (C) and at least one of (B) or (D).

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body

of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Thus, the language stating that the lubricating oil composition is for industrial machinery equipment is not afforded patentable weight.

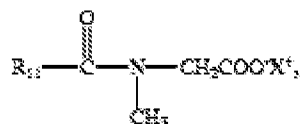
Baba also discloses N-Oleyl sarcosinic acid (P20 Table 3) and sarcosines and their derivatives (P6 L18-22)

Baba does not expressly disclose the type of sarcosine derivative to be an alkali or alkaline metal salt.

Reyes Gavilan et al. (US 6,410,490) discloses a lubricant composition stabilized against the deleterious effects of heat and oxygen (Abstract). The composition of Reyes Gavilan comprises many of the same components as that of Baba.

Reyes Gavilan discloses the lubricating composition similar to that of Baba in that it comprises oil (C2 L1) and an effective stabilizing amount of an N-acyl sarcosine

(VII)



wherein

the acyl group $\text{R}_{11}-\text{C}(=\text{O})-$ is the residue of a fatty acid having 10 to 20 carbon atoms and X^+ is the hydrogen ion, an alkali metal ion or an ammonium ion.
derivative of formula:

Reyes Gavilan discloses the derivative comprises a hydrogen ion, an alkali metal ion or an ammonium ion meeting the limitation for Y^1 alkali metal or alkali earth metal of formula C-(2). (Reyes Gavilan C3 L30-45 and C7 L20-30) Reyes Gavilan discloses the

Art Unit: 1797

composition further comprises stabilizing amounts of a polyol partial ester of mono glycerides and polyols (C7 L31-43) as well as antioxidants of thiodipropionic esters/ethers (C9 L62-68) Reyes Gavilan discloses additional rust inhibitors of phosphoric acid partial esters and zinc dialkylthiophosphate (C10 L60-65). Reyes Gavilan disclose the composition comprises triphenylphosphorothionate (component A-2 C11 L52-54). Reyes Gavilan discloses the composition further comprises viscosity index improvers such as polymethacrylate (C11 L38-44) meeting the limitation for component (B)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use an alkali metal sarcosine derivative as in Reyes Gavilan as the sarcosine derivative of Baba as it is suitable for use in lubrication compositions and since Baba expressly contemplates a sarcosine derivative as such use of the alkali metal sarcosine derivative would amount to nothing more than use of a known substance in a known environment to achieve an entirely expected result.

Regarding Claim 14:

The rejection to claims 1 and 10 above are expressly incorporated herein. Modified Baba discloses the limitations set forth above.

Modified Baba discloses the composition consisting essentially of (C-1) and/or (C-2) thereby meeting the limitations of claim 14 for synthetic oil and component (C)

The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52,

Art Unit: 1797

190 USPQ 461, 463 (CCPA 1976) (emphasis in original)

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Thus, the language stating that the lubricating oil composition is for industrial machinery equipment is not afforded patentable weight.

Response to Arguments

12. Applicant's arguments filed 12/14/2009 have been fully considered but they are not persuasive. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAMELA WEISS whose telephone number is (571)270-7057. The examiner can normally be reached on Mon.-Thur. 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/pw/

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797